

REMARKS

Claims 1 through 3, 5 through 9, 11 through 16 and 18 through 20 are pending in the case.

Claims 4, 10 and 17 have been canceled.

Claims 1, 5, 7, 11, 13, 14, 18 and 19 have been amended.

Claims 2, 3, 8, 9, 15 and 16 are subject to restriction.

Claims 1, 4 through 7, 10 through 14 and 17 through 20 have been rejected.

Rejection of claims under 35 U.S.C. § 112, first paragraph

Examiner has rejected claims 1, 4 through 7, 10 through 14 and 17 through 20 under 35 U.S.C. § 112, first paragraph as based on a disclosure which is not enabling. Applicant respectfully traverses the rejection.

Examiner's rejection appears to be based on a misunderstanding of the requirement of the first paragraph 35 U.S.C. § 112.

The first paragraph 35 U.S.C. § 112 sets out that the specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention. Applicant has fulfilled this requirement.

Examiner has provided the following rationale for the rejection:

The reflection optical switch system is only stated in the preamble of the claim. The detail structure of the optical switch is not claimed in the body of the claim. It is not clear how the claimed structure can be operated as a reflection optical switch system.

Examiner appears to be under the mistaken impression that the claims themselves need to be enabling. This is incorrect. The first paragraph 35 U.S.C. § 112 requires only that the disclosure be enabling. It is not necessary for the claims to contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same. Such a description is contained in the disclosure and thus does not need to be contained in the claims.

Rejection of claims under 35 U.S.C. § 112, second paragraph

Examiner has variously rejected claims 4, 5, 7, 10, 17 and 18 under 35 U.S.C. § 112, second paragraph. Applicant has amended the claims to overcome the rejection.

Specifically, Applicant has amended claim 7 to indicate that “the gettering structures including heating components which, when actuated, absorb impurities from the fluid stored in the chamber”.

Applicant has replaced the term “optically accessible from outside the chamber” with the synonymous term “can be optically detected from outside the chamber”.

Applicant has replaced the term “coupon structures” with the synonymous term “rectangular-shaped structures”. See, for example, coupon structures 42, 43 and 44 shown in Figure 3.

Rejection of claims under 35 U.S.C. § 102

Applicant has rejected claims 1, 6, 7, 12, 14 and 20 under 35 U.S.C. § 102(e) as being anticipated by USPN 6,477,222 (Nystrom). Applicant has amended the claims to overcome the rejection. Specifically, Applicant has amended independent claim 1 to include the limitations formerly in claim 4. Applicant has amended independent claim 7 to include the limitations formerly in claim 10. Applicant has amended independent claim 14 to include the limitations formerly in claim 17.

Rejection of claims under 35 U.S.C. § 103

Applicant has rejected claims 4, 5, 10, 11, 13 and 17 through 19 under 35 U.S.C. § 103 as being unpatentable over Nystrom. Applicant respectfully traverses the rejection and requests reconsideration.

Applicant has amended claims 13 and 19 to be in independent form. Applicant has amended independent claim 1 to include the limitations formerly in claim 4. Applicant has amended independent claim 7 to include the limitations formerly in claim 10. Applicant has amended independent claim 14 to include the limitations formerly in claim 17. Applicant, therefore, herebelow treats this rejection as being a rejection of all the claims in this case.

Statement of Common Ownership

USPN 6,477,222 (Nystrom) and the present patent application (SERIAL NO: 10/625,818, FILED: July 23, 2003) were, at the time the invention of the present patent application was made, owned by Agilent Technologies, Inc.

Discussion of Rejection of claims under 35 U.S.C. § 103

Examiner apparently believes Nystrom qualifies as prior art under 35 U.S.C. § 102 (e). However, 35 U.S.C. § 103 (c) indicates the following:

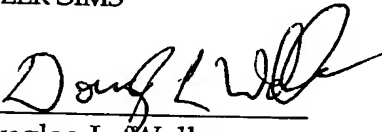
Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Nystrom cannot preclude patentability of the claims of the present case under 35 U.S.C. § 103(a) as Nystrom and the present patent application were, at the time the invention of the present patent application was made, owned by Agilent Technologies, Inc.

Conclusion

Applicant believes this Amendment has placed the present application in condition for allowance and favorable action is respectfully requested.

Respectfully submitted,
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